

## **REMARKS**

Claims 1-24 are pending in this application. No amendments are made.

### **Claim Rejections Under 35 U.S.C. §103 over Onomichi in view of Ito**

Claims 1, 2, 4, and 13 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Application Publication No. 2001/0005278 (“Onomichi”) in view of U.S. Patent No. 6,699,580 (“Ito”). Applicants respectfully traverse the rejections.

The Advisory Action dated October 10, 2008 indicates that the Response under 37 C.F.R. §1.116 filed September 23, 2008 was entered, but the rejections of claims 1-24 were maintained. The Advisory Action indicates that the rejections of claims 1-24 were based on certain misinterpretations of the disclosures of Onomichi. For example, the Advisory Action states that “water is used in addition to the organic solvent within that IR layer (paragraph [00162])” (page 2, lines 4-5, Advisory Action) and that “Onomichi discloses that the organic solution is also added with water (paragraph [0163])” (page 2, line 8, Advisory Action). Applicants point out that paragraphs [0162] and [0163] of Onomichi disclose a coating solution for the easy adhesion layer, not the infrared absorption layer (“IR layer”). Contrary to the Examiner’s statement, there is no teaching in Onomichi that the IR layer contains water. See paragraph [0183]; Table 1.

The Advisory Action also states that “Onomichi states that surfactants are used to improve ... handling properties such as winding properties of the substrate film (paragraph [0164]).” See page 2, lines 5-6, Advisory Action. But the improvement of handling properties, such as winding properties, is not due to surfactants, but due to the particles added to the easy adhesion layer (paragraph [0164], lines 3-7). Thus, Onomichi does not teach or suggest that surfactants are used to improve the handling properties of the substrate film in Onomichi.

Furthermore, it is stated in the Advisory Action that “the primary reference” discloses the use of surfactant to “prevent foaming.” See page 2, lines 12-13. However, the primary reference, Onomichi, does not disclose that surfactants can be used to prevent foaming. In paragraph [0162], Onomichi merely discloses the addition of a surfactant to an aqueous coating solution used to coat the surface of a substrate film in order to improve wetting of the substrate film and to coat the coating solution uniformly. Applicants further point out that the aqueous coating

solution containing surfactant is used to form the easy adhesion layer, not the IR layer (paragraph [0162]).

From the forgoing discussions, it is clear that the IR layer of Onomichi uses an **organic solvent** and does NOT contain water. See paragraphs [0183] and [0233]; Table 1. On the other hand, the surfactant in Ito is used in a solvent which is water alone or a mixture of water and an organic solvent compatible with water (column 5, lines 30-39). The Examiner acknowledged in page 2, lines 11-12 of the Advisory Action that “[t]he solvent mixture (water alone or uses of organic solvent with water) is also considered to be an **“aqueous solution.”**” Thus, the surfactant in Ito is used in an **aqueous** solution. Unlike Ito, Onomichi uses **organic solvents**, such as methyl ethyl ketone, tetrahydrofuran and toluene in the IR layer (paragraphs [0183] and [0233]; Table 1). The IR layer coating solution of Onomichi does not contain water and is NOT an aqueous solution. Thus, there would not have been any motivation or reasonable expectation of success to modify the IR layer of Onomichi, which uses an **organic solvent**, by adding a surfactant used in an **aqueous** solution in Ito. Further, as discussed in the Response under 37 C.F.R. §1.116 filed September 23, 2008, the two reasons disclosed by Ito for using polysiloxanes with HLB value from 3 to 18, *i.e.*, to improve water/polysiloxane compatibility and to prevent foaming, do not apply to the IR layer of Onamichi, which uses an **organic solvent**, not water.

For at least the reasons stated above, claims 1, 2, 4, and 13 would not have been obvious under 35 U.S.C. §103(a) over Onomichi in view of Ito. Withdrawal of the rejections is respectfully requested.

**Claim Rejections of claims Under 35 U.S.C. §103 over Onomichi in view of Ito as applied to claim 1 and further in view of other references**

Claims 3 and 9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent Application Publication No. 2002/0127395<sup>1</sup> (“Kuwabara”). Claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of Japanese Patent Application 2004-202899 (“Sato”). Claims 6 and 7 stand rejected under

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<sup>1</sup> Applicants have noted that US 2002/375766, as recited on page 4 of the Final Office Action, does not exist. Instead, US 2002/0127395 fits the description of Kuwabara.

35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent No. 6,703,138 (“Taki”). Claim 8 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent Application Publication No. 2003/0186040 (“Oya”). Claims 10 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent Application Publication No. 2003/0021935 (“Moriwaki”). Claims 11 and 12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of Japanese Patent Application 2003-127310 (“Kumano”). Applicants traverse the rejections.

For the reasons stated above, claim 1 is not obvious over Onomichi in view of Ito. The deficiency of Onomichi in view of Ito is not cured by any of Kuwabara, Sato, Taki, Oya, Moriwake, Kumano, and combinations thereof because none of them suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito. Claims 3, 5-9, 10-12, and 24 would not have been obvious under 35 U.S.C. §103(a) over Onomichi in view of Ito, or further in view of Kuwabara, Sato, Taki, Oya, Moriwake, Kumano, and combinations thereof. Withdrawal of the rejections is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103 over Onomichi in view of Ito as applied to claim 13 and further in view of other references**

Claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 13 and further in view of U.S. Patent No. 6,770,430 (“Kubo”). Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 13 and further in view of U.S. Patent Application Publication No. 2004/0071883 (“Ogawa”). Applicants traverse the rejections.

For the reasons stated above, claim 13 (and all claims dependent therefrom) is not obvious over Onomichi in view of Ito. The deficiency of Onomichi in view of Ito is not cured by any of Kubo and Ogawa at least because none of them suggests one of ordinary skill in the art to

modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito. Therefore, withdrawal of the rejections is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103 over Onomichi in view of Ito and further in view of Kumano and other references**

Claim 17 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and further in view of Kumano. Claim 18 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Kumano as applied to claim 17 and further in view of U.S. Patent No. 4,948,635 (“Iwasaki”). Claim 19 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Kumano as applied to claim 17 and further in view of Ogawa. Applicants traverse the rejections.

For the reasons stated above, there would have been no motivation and no reasonable expectation of success to combine Onomichi and Ito to reach a process for preparing a near-infrared ray absorption roll using a coating solution containing, among other things, a near-infrared ray absorption dye and a surfactant, as recited in independent claim 17, and evidence of the importance of the HLB range of 2 to 12 and the concentration range of 0.01% to 2.0% by mass is disclosed in the specification. The deficiency of Onomichi in view of Ito is not cured by any of Kumano, Iwasaki, Ogawa, and combinations thereof at least because none of them suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito.

Therefore, withdrawal of the rejections is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103 over Onomichi in view of Ito and further in view of Iwasaki and other references**

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and further in view of Iwasaki. Claim 22 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Iwasaki as applied to claim 20 and further in view of Ogawa. Claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Iwasaki as applied to claim 20 and further in view of Kubo. Applicants traverse the rejections.

For the reasons stated above, there would have been no motivation and no reasonable expectation of success to combine Onomichi and Ito to reach a process for preparing a near-infrared ray absorption roll using a coating solution containing, among other things, a near-infrared ray absorption dye and a surfactant, as recited in independent claim 20, and evidence of the importance of the HLB range of 2 to 12 and the concentration range of 0.01% to 2.0% by mass is disclosed in the specification. The deficiency of Onomichi in view of Ito is not cured by any of Kumano, Iwasaki, Ogawa, and combinations thereof at least because none of them suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito.

Therefore, withdrawal of the rejections is respectfully requested.

### CONCLUSION

Applicants assert that all of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

In the event the filing of this paper is deemed not timely, Applicants petition for an appropriate extension of time. The petition fee, if needed, can be charged to Kenyon & Kenyon LLP's Deposit Account 11-0600. The Office is hereby authorized to charge any additional fees or credit any overpayments to Kenyon & Kenyon LLP's Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON LLP

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